



JENKENS & GILCHRIST PC
3200 FOUNTAIN PLACE
1445 ROSS AVE
DALLAS, TX 75202-2799

COPY MAILED

APR 21 2004

OFFICE OF PETITIONS

In re Application of
Chien; Hon; and Lai
Application No. 09/434,318
Filed: November 4, 1999
Attorney Docket No. 45688-00002

:
:
: DECISION REFUSING STATUS
: UNDER 37 CFR 1.47(b)
:

This is in response to the petition under 37 CFR 1.47(a), filed June 2, 2000 and supplemented on July 5, 2000, which has been treated as a petition under 37 CFR 1.47(b).¹

The petition is dismissed.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to respond, correcting the below-noted deficiencies. Any response should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(b)" and may include an oath or declaration executed by the inventor. Failure to respond will result in abandonment of the application. Any extensions of time will be governed by 37 CFR 1.136(a).

A grantable petition under 37 CFR 1.47(b) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration; (2) an acceptable oath or declaration; (3) the petition fee; (4) a statement of the last known address of the non-signing inventor; (5) proof of proprietary interest; and (6) proof of irreparable damage. Applicant lacks item (1) set forth above.

As to item (1), Rule 47 applicant has failed to show or provide proof that the nonsigning inventors have refused to sign the declaration after having been presented with a copy of the

¹ A petition under 37 CFR 1.47(a) is inappropriate in this instance since none of the inventors has signed the declaration. A petition under 37 CFR 1.47(a) is only appropriate where at least one of the inventors has signed the declaration; accordingly, the petition will be treated as a petition under 37 CFR 1.47(b).

The instant petition was only brought to the attention of the deciding official. The Office sincerely apologizes for the delay in replying to the instant petition and inconvenience caused petitioner by this delay.

application papers (specification, claims, and drawings). Before an allegation can be made that the inventors have refused to sign an oath or declaration, they must have been presented with a copy of the application papers. The current record fails to demonstrate that the inventors were ever presented with a copy of the application papers prior to the alleged refusal to execute the declaration. Did the nonsigning inventors receive a copy of the application papers? Unless the nonsigning inventors were presented with a copy of the application papers, they could not attest that they have "reviewed and understand the application papers" and therefore could not sign the declaration for the instant application. See MPEP 409.03(d). Unless petitioner can show that a copy of the application papers was presented to each of the nonsigning inventors, then petitioner will have to mail a copy of the complete application papers to the last known address of the inventors, return receipt requested. A cover letter of instructions should accompany the mailing of the application papers setting a deadline or a statement that no response will constitute a refusal. This sort of ultimatum lends support to a finding of refusal by conduct. The proof of the pertinent events should be made by a statement of someone with firsthand knowledge of the events and should include documentary evidence, such as certified mail return receipt, cover letter of instructions, telegrams, etc. See MPEP 409.03(d).

The evidence in the record, i.e., "A Post Certified Letter" (which is a translation of the letter) dated March 7, 2000, addressed to each of the nonsigning inventors, and requesting that they sign the Oath and Assignment, indicates that Mr. Wesley Shen, a senior staff member of Uni Light, spoke by telephone to each of the nonsigning inventors at 3:00 p.m. on March 3, 2000, and that each of the three nonsigning inventors refused to sign the Oath and Assignment. However, it is unclear how each of the nonsigning inventors verbally refused to sign at the same time unless there was a conference call. Accordingly, petitioner should provide an explanation as to how each of the nonsigning inventors verbally refused telephonically to execute the oath and assignment at the same time.

Further, it is unclear from the declaration of Mr. Fzung Feng Wu, President of Uni Light Technology Corporation, whether nonsigning inventor Schang-Jing Hon was unable to be located to execute the declaration. More specifically, the declaration of Mr. Wu states: "I believe that Schang-Jing Hon has moved to Germany, but I do not know how to reach him." While it appears that Mr. Shen was able to contact inventor Hon telephonically on March 3, 2000, it is now asserted by Mr. Wu that inventor Hon cannot be located. Accordingly, an explanation is required as to why inventor Hon cannot now be located. Petitioner is reminded that the applicable statute (35 USC 116) requires that a "diligent effort" have been expended in attempting to find or reach the nonsigning inventor(s). See MPEP 409.03(a).

Where inability to find or locate a named inventor(s) is alleged, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a *diligent effort* was made to locate the inventor. The statement(s) of fact must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay, will not normally be accepted. Since petitioner has access to inventor Hon's employee

records, petitioner should indicate what an inspection of the records reveals as to a current address, forwarding address, or an address of the nearest living relative. What does inspection of the phone directories for those address locations reveal? Did any of Mr. Hon's co-workers keep in touch with him? At the very least, a search should be made of the telephone directories and any regional or national registry(s). Copies of the results of the search must be referred to in any renewed petition. See MPEP 409.03(d). If inventor Hon is located, then a complete copy of the application papers (specification, claims, drawings, oath, etc.) Should be mailed to Mr. Hon's address, return receipt requested, along with a cover letter of instructions which includes a deadline or a statement that no response will constitute a refusal. This sort of ultimatum lends support to a finding of refusal by conduct. If the papers are returned and all other attempts to locate or reach the inventor, e.g., through personnel records, co-workers, E-mail, the Internet or the telephone, etc., continue to fail, then applicant will have established that inventor Hon cannot be reached or has refused to join in the application. The statements of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein.

If inventor Hon is located and the inventor orally refuses to join in the application or where there is an express or oral refusal by the other two nonsigning inventors, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. If, on the other hand, petitioner receives an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

When it is concluded by the rule 47 applicant that an omitted inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in an affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence must be submitted.

Whenever an omitted inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

After this decision is mailed, deposit account No10-0447 will be charged a total of \$1,490.00 -- \$130.00 for the petition fee and \$1,360.00 for four-month extension of time fee.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop PETITION
Commissioner for Patents
Post Office Box 1450
Alexandria, VA 22313-1450

By hand: Crystal Plaza Two, Lobby
2011 South Clark Place
Room 1B03
Arlington, VA 22202

By fax: (703) 872-9306
Attn: Office of Petitions

Telephone inquiries related to this decision should be directed to Wan Laymon at (703) 306-5685.



Frances Hicks

Lead Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy